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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,908	08/16/2001	Steven C. Quay	18072-000810US	1694
20350	7590	07/12/2005		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BAYAT, BRADLEY B	
			ART UNIT 3621	PAPER NUMBER

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,908

Applicant(s)

QUAY ET AL.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-19 remain pending and are again presented for examination on the merits.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2005 has been entered.

Response to Arguments

Applicant's arguments with respect to the above noted claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiRienzo, US 6,006,191 in view of Seymour et al. (hereinafter Seymour), US 6,871,190 B1.

1. As per claims 1 and 16, DiRienzo discloses a method of soliciting bids offering pharmaceutical or medical device goods or services to a client requesting said goods and

Art Unit: 3621

services, said method comprising: posting a proprietary template descriptive of said good or service to an interactive online bidding site and accepting from the first entity a bid to provide said good or service (column 11, lines 50-58; columns 16, 17 and 30). Although DiRienzo does disclose a categorization feature as part of the RAMIX system, he does not explicitly disclose a term search function as per the characteristics of the goods or service placed for bid.

Seymour, however, teaches a dynamic and comprehensive interactive bidding system which includes a search template for inputting a search characteristic or criteria for the desired merchandise (column 6, lines 1-30). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine, modify and utilize this feature as part of a bidding system as numerous goods and services are offered and a bidder needs to be able to efficiently identify and access sought after goods or services based upon selected characteristics.

2. As per claim 2, DiRienzo further discloses the method according to claim 1 further comprising, in response to a request from a second entity, identifying a current set of bids for said good or service (figure 6, patient bid queues).

3. As per claim 3, DiRienzo further discloses the method according to claim 1 wherein the client can observe live bidding for providing said good or service (column 19, lines 13-43, column 25, lines 47-column 26, line 19).

4. As per claim 4, DiRienzo further discloses the method according to claim 1, wherein said provider of a good or service is a contract service organization with expertise in the good or

Art Unit: 3621

service under consideration (column 16, lines 30-45; column 22, line 1).

5. As per claim 5, DiRienzo further discloses the method according to claim 1, wherein said client is a member selected from a group consisting of a developer or manufacturer of a medical device, a developer or manufacturer of a medical procedure, a developer or manufacturer of a diagnostic agent, a developer or manufacturer of a therapeutic agent and combinations thereof (column 7, lines 62-65; column 26, lines 42-50).

6. As per claim 6, DiRienzo further discloses the method according to claim 1 wherein access to the site is by secure means and bids are accepted from authorized users only (column 20, lines 26-47, column 25, lines 18-46)

7. As per claim 7, DiRienzo further discloses the method according to claim 1 wherein an identity of the client may be optionally disclosed to bidders or potential bidders (column 7, lines 36-65, column 11, lines 17-50).

8,9. As per claims 8 and 9, DiRienzo discloses a method of soliciting bids offering pharmaceutical or medical device goods or services to a client requesting said goods and services, said method comprising: posting a proprietary template descriptive of said good or service to an interactive online bidding site and accepting from the first entity a bid to provide said good or service (column 11, lines 50-58; columns 16, 17 and 30). Although DiRienzo does disclose a categorization feature as part of the RAMIX system, which includes predetermined

Art Unit: 3621

criteria inputted by a bidder, he does not explicitly disclose a term search function and automatic matching mechanism displaying results based on previously saved criteria.

Seymour teaches a dynamic and comprehensive interactive bidding system that includes a search template for inputting a characteristic of a good or service and intelligent bidder agent and interpreter to compare and display the newly matching offered goods (column 5, lines 27-58, column 6, lines 1-30). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine, modify and utilize this feature as part of a bidding system as numerous goods and services are offered and a bidder needs to be able to efficiently identify and access sought after goods or services based upon selected characteristics. Motivation to combine and utilize the automatic matching feature taught by Seymour is further supported by the need to provide time sensitive matching, bidding and assessment in a medical/pharmaceutical environment wherein a patient's health is concerned.

17-19. As per claims 17-19, DiRienzo discloses a method of a receiving from a first entity a request for a medical/diagnostic service, providing a description of said service to the first entity and accepting a bid to provide said service (summary of the invention, columns 16, 17 and 30). Although DiRienzo does disclose a categorization feature involving various medical services as part of the RAMIX system, he does not explicitly disclose a term search function as per the characteristics of the service placed for bid. Seymour, however, teaches a dynamic and comprehensive interactive bidding system which includes a search template for inputting a search characteristic or criteria for the desired merchandise (column 6, lines 1-30). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine,

Art Unit: 3621

modify and utilize this feature to enable a bidder to efficiently identify and timely bid on sought after goods or services based upon desired criteria among the countless available goods or services.

Seymour does not expressly disclose a method wherein a CSO is operable to perform one or more of the following tasks: literature review, meta-analysis, prepare and submit INDs, perform medical writing, author transcripts, edit for publication, organize and attend meetings with regulatory agencies. Seymour further does not show collection of data comprising one or more of the following: number of arms, sample sizes, length of trial, number of centers...etc.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The collection of data would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect any type of data and provide a description based on a match against the database content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 12-15 directed to system and apparatus comprising the elements recited in claims 1-9 are rejected as above.

Claim Rejections - 35 USC § 102

Art Unit: 3621

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher et al., US 5,835,896.

As per claims 10 and 11, Fisher et al. disclose:

10. A computer site for a supplier of a good or service to bid on a client request for bids on said good or service, said site comprising at least one web computer server serving a plurality of computer browsers and enabling said browsers to participate in at least one bidding cycle, wherein said at least one bidding cycle is initiated by a client requesting entry of bids by suppliers of a good or service, said web server communicating with a separate database computer separated from said web server by a firewall, said database computer being accessible to said at least one web computer server to allow retrieval of information relevant to said good or service open for bid, said web server computer including application software for bidding on said good or service open for bid by (column 6, lines 1-30):

(a) displaying to each said browser during a bidding cycle a parameter for said good or service up for bid (fig 4, catalog page generator 25);

(b) displaying to each said browser a current bid for said good or service up for bid, and a measure of time remaining in said bidding cycle (column 7, line 66-column 8, line 4);

(c) providing a user control for indicating instructions to enter a bid to provide said good or service open for bid (column 7, lines 50-65) ; and

(d) updating to each said browser said current bid and said measure of time remaining in said bidding cycle to provide dynamic feedback to each said browser (column 8, lines 5-14).

11. The computer site according to claim 10 wherein said database computer is accessible to said at least one web computer server to allow retrieval of information relevant to said supplier of a good or service (column 8, lines 42-67).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,611,846 B1 to Stoodley.
- US PAP 2002/0002513 A1 to Chiasson.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a horizontal line extending to the right.

Bradley B. Bayat
Patent Examiner
Art Unit 3621